

Attorney Docket No.: RTSP-0100
Inventors: Monia and Cowser
Serial No.: 09/763,748
Filing Date: May 29, 2001
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REMARKS

Claims 1, 2 and 5-8 are pending in the instant application. Claims 1, 2 and 5-8 have been rejected. Reconsideration is respectfully requested in light of the following remarks.

I. Double Patenting

Claims 1, 2 and 5-8 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of US Patent No. 6,077,672. The Examiner suggests that although the conflicting claims are not identical, they are not patentably distinct from each other. Applicants are filing herewith a terminal disclaimer as required under 37 CFR 1.13(b). Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims Under 35 U.S.C. 103(a)

Claims 1, 2 and 5-8 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Goeddel et al. (US Patent 5,563,039) in view of Froehler (US Patent 5,256,775). The Examiner suggests that it would have been *prima facie* obvious to one of ordinary skill to make antisense sequences as taught by Goeddel et al., and to modify them as taught by Froehler et al. Further, the Examiner suggests one of skill would have been motivated because Goeddel teach that

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inhibition of TRADD may inhibit undesirable cell growth, such as cancer. The Examiner suggests that the reasonable expectation of success is provided by these references as well. Applicants respectfully traverse this rejection.

Goeddel et al. (US Patent 5,563,039) generally discloses antisense inhibition of TRADD expression. The present invention claims antisense compounds 8 to 30 nucleotides in length targeted to a nucleic acid molecule encoding human TRADD of SEQ ID NO:1, wherein said antisense compounds inhibit the expression of human TRADD. Nowhere does the Goeddel patent teach use of antisense compounds of 8 to 30 nucleotides in length, nor does it teach antisense targeted to SEQ ID NO:1 as identified in the present application. Therefore the cited patent fails to teach or suggest the claimed invention.

The secondary reference cited fails to overcome the deficiencies in teaching of the primary reference.

Froehler (US Patent 5,256,775) discloses the general modification of antisense compounds with sugar and internucleoside linkages. Nowhere does this patent teach or suggest antisense compounds targeted to human TRADD of SEQ ID NO: 1 as claimed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some

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suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art must teach or suggest all claim limitations. Clearly, the combination of prior art cited fails to teach or suggest the limitations of the claims as filed, which claim antisense compounds targeted to human TRADD of SEQ ID NO: 1, and thus cannot render the instant claimed invention obvious. Withdrawal of this rejection is respectfully requested.

III. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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